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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,072	SCHRENK, ROGER A.	
	Examiner	Art Unit	
	Naeem Haq	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/16/04; 11/01/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1 and 9 are objected to because of the following informalities: This claim recites the phrase "...deciphering the language of design **the** includes a substantially infinite..." (emphasis added) in line 7 of claim 1 and line 5 of claim 9. The examiner believes that the word "the" should be replaced with the word "that" as done so by the Applicant in claim 17, lines 3 and 4. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 1: This claim is directed to a "system". This system comprises three components: (1) a graphical search engine, (2) a graphical reference library, and (3) search means for locating items. Applicant's specification appears to suggest that all three components are software. However, the examiner notes that software, by itself, is not a physical entity. In its reasonably broad sense, software is nothing more than a collection of steps to be followed. Therefore, none of the components listed in the claim recite anything physical to constitute a "system" (i.e. an apparatus). Claims 2-8 are dependent on claim 1 and are rejected under the same rationale.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite the limitation "...the language of design that includes a substantially infinite number of stylistic combinations". The examiner notes that storing an infinite number of stylistic combinations in a database would require the database to have infinite capacity. The Applicant's specification does not disclose to one of ordinary skill in the art how to construct a database with infinite capacity. For this reason, this limitation lacks enablement.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 1-8: As noted above in the 101 analysis, these claims are directed to a "system". However, none of the components listed in the claim recite

Art Unit: 3625

anything physical to constitute a "system" (i.e. an apparatus). Therefore, it is unclear to the examiner how three software programs can be regarded as a "system".

Referring to claims 1-21: These claims recite the limitation "...substantially infinite number..." The term "substantially infinite" in claim is a relative term which renders the claim indefinite. This term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. These claims also recite the limitation "...the alphabet deciphering the language of design..." It is unclear to the examiner what this limitation means. For these reasons, these limitations are rendered indefinite.

Referring to claims 2-8: This claim is directed to a system. However, this claim also recites the method steps "listings of unique items..." and "aggregate buyers and sellers..." This type of claim is rendered indefinite because the "metes and bounds" of the claim is unclear to the Examiner.

Whether a single claim covering both an apparatus and a method of use of that apparatus is invalid is an issue of first impression in this court. The Board of Patent Appeals and Interferences ("Board") of the PTO, however, has made it clear that reciting both an apparatus and a method of using that apparatus renders a claim indefinite under section 112, paragraph 2. Ex parte Lyell, 17USPQ2d 1548 (BPAI 1990). As the Board noted in Lyell, "the statutory class of invention is important in determining patentability and infringement." Id. at 1550 (citing In re Kuehl, 475 F.2d 658, 665 [177 USPQ 250] (CCPA 1973); Rubber Co. v. Goodyear, 76 U.S. 788, 796 (1870)). The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. Id. Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. Id. at 1550-51. This rule is well

Art Unit: 3625

recognized and has been incorporated into the PTO's Manual of Patent Examination Procedure. §2173.05(p)(II) (1999) ("A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph."); (IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (CAFC 2005)).

Thus the Federal Circuit has held that a claim, which overlaps two statutory classes of invention, is indefinite. Dependent claims 2-8 are rejected under a similar rationale.

Referring to claim 15: The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 7, 9, 10, 13, 14, 15, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/93156 A1 ("WIPO").

Referring to claims 1 and 2: WIPO discloses a system for providing aggregation of buyers and sellers over the Internet comprising:

- a graphical search engine for locating unique items sought by buyers on the Internet (page 2, lines 9-11; page 5, lines 15-19). The Applicant's specification discloses that a search engine is a website that a buyer uses

to search for an item ([0017] and [0040]). WIPO provides the same teaching.

- a graphical reference library for use by sellers for listing unique items and including a substantially infinite number of stylistic combinations (page 2, lines 5-9; page 6, lines 5-20; page 7, lines 13-20);
- listings of unique items placed on the internet by sellers of designs, furnishings and accessories including relevant physical characteristics of the unique items for sale (page 5, lines 3-5; page 7, lines 13-17);
- search means for use by buyers for locating desired unique items by specified relevant physical information. The Applicant's specification teaches that the search means is a web based interface for graphical searching ([0002]). WIPO teaches a web based interface (page 4, lines 15-20; page 5, lines 15-17) that is used for graphical searching (claim 4 and claim 6);
- to thereby aggregate buyers and sellers of unique items through online internet communication (Figure 1; page 4, line 13 – page 5, line 7).

WIPO does not teach that the library comprises a graphical alphabet of component parts of unique items to be listed, the alphabet deciphering the language of design.

However, the Examiner notes that this limitation is not functionally or structurally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The structural elements of the system would be the same regardless of what information the library contained. The differences between the

Art Unit: 3625

content of the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place a graphical alphabet in the library of the invention of WIPO because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 5: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. The cited prior art does not teach that advertisements bearing a geographical relationship to a buyer, a seller or the location of a unique item are presented to the buyer. However, the Examiner notes that this limitation is not functionally or structurally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The structural elements of the system would be the same regardless of what sort of advertisements were presented to the buyer. The differences between the content of the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at

Art Unit: 3625

the time the invention was made to present advertisements to a buyer in the invention of WIPO because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 6: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. The cited prior art also teaches that the relevant physical information includes dimensions or materials of construction (page 6, lines 5 and 6).

Referring to claim 7: The cited prior art teaches or suggests all the limitations of claim 6 as noted above. The cited prior art also teaches that additional information is given regarding the price of the unique item (claims 7, 14, and 16).

Referring to claims 9 and 17: Claims 9 and 17 are rejected under the same rationale as set forth above in claim 1.

Referring to claims 10 and 18: Claims 10 and 18 are rejected under the same rationale as set forth above in claim 2.

Referring to claim 13: Claim 13 is rejected under the same rationale as set forth above in claim 5.

Referring to claims 14 and 20: Claims 14 and 20 are rejected under the same rationale as set forth above in claim 6.

Referring to claim 15: Claim 13 is rejected under the same rationale as set forth above in claim 7.

Claims 3, 4, 11, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/93156 A1 ("WIPO") in view of Broussard et al. (US 2004/0019528 A1) ("Broussard").

Referring to claims 3 and 4: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. The cited prior art does not teach that the buyers and sellers are aggregated according to geographical location or that the geographic location of buyers and sellers is determined by zip code. However, Broussard teaches a purchasing system that aggregates buyers and sellers according to geographical location ([0171]) and wherein the geographic location of buyers and sellers is determined by zip code ([0177] and [0179]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Broussard into the invention of WIPO. One of ordinary skill in the art would have been motivated to do so in order to provide a buyer with the option of doing business with a local vendor, as taught by Broussard.

Referring to claims 11, 12, and 19: Claims 11, 12, and 19 are rejected under the same rationale as set forth above in claims 3 and 4.

Claims 8, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/93156 A1 ("WIPO") in view of Coden et al. (US 5,873,080) ("Coden").

Referring to claim 8: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. The cited prior art does not teach that the system has a text based searching capability in addition to the graphical search engine. However, Coden

Art Unit: 3625

teaches a system and method of searching multiple databases wherein the user interface has a text based searching capability in addition to the graphical search engine (Figure 3, "312", "313", "316", and "317"; col. 9, lines 9-39). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Coden into the invention of WIPO. One of ordinary skill in the art would have been motivated to do so in order to allow a buyer to use a single query to search a collection of documents that contain a mixture of media types, as taught by Coden (col. 3, lines 17-30).

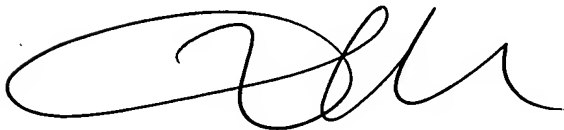
Referring to claims 16 and 21: Claims 16 and 21 are rejected under the same rationale as set forth above in claim 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naeem Haq, Primary Examiner
Art Unit 3625

September 20, 2006